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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,272	04/19/2000	Li Fang	913.6600CIP	3198
35811	7590	12/12/2005	EXAMINER	
IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP 1650 MARKET ST SUITE 4900 PHILADELPHIA, PA 19103			EPPS FORD, JANET L	
		ART UNIT	PAPER NUMBER	
		1633		
DATE MAILED: 12/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/552,272	FANG ET AL.	
	Examiner Janet L. Epps-Ford	Art Unit 1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,5,6,10 and 14-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1,5,6,10,14 and 15 is/are allowed.
- 6) Claim(s) 14-65 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 April 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 5-6, 10, and 14-65 are presently pending.

Response to Arguments

3. Those rejections set forth in the prior Office Action that are not repeated in the instant Office Action have been withdrawn in response to Applicant's amendment and/or arguments.

Claim Rejections - 35 USC § 112

4. Claims 16-65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record set forth in the Official Action mailed 11-19-02.
5. Applicant's arguments filed 9-23-05 have been fully considered but they are not persuasive. Applicants traversed the instant rejection by way of amendment, and on the grounds that the specification includes a full written description for the entire scope of the various claim elements. According to Applicants, they have provided a direct correlation between structure and function by defining the genus of nucleotide acid fragments according to the present invention, as those nucleic acid fragments that will hybridize under high stringency conditions to a reference nucleic acid that is precisely complementary to one of SEQ ID NOs: 48-50. Contrary to Applicant's assertions, since

the claims are to be given the broadest reasonable interpretation consistent with the specification (See MPEP § 2111 - § 2116.01), the claims can be interpreted as reading on a genus of nucleic acid fragments, of undefined length and origin (the claims do not recite fragments of SEQ ID NO: 48-50) that will hybridize under high stringency conditions to a *reference nucleic acid, of undefined length and origin* that comprises a region that is precisely complementary to one of SEQ ID NO 48-50, or precisely complementary to a subregion of one of SEQ ID NO: 48-50 (the claims do not recite precisely complementary to the full length sequence of one of SEQ ID NO: 48-50). The scope of nucleic acid fragments that are encompassed by the claims are not limited to those sequences that will hybridize under high stringency conditions to a reference nucleic acid that is precisely complementary to the full length sequence of one of SEQ ID NO: 48-50, wherein said reference nucleic acid sequence is of identical length to the sequence of SEQ ID NO: 48-50 to which it is precisely complementary.

Moreover, Applicant's have further amended the claim to recite wherein the first nucleic acid fragment is "identical to a sequence found in a first bacterial nucleic acid molecule comprising a first cold shock inducible gene..." Again, there is no length requirement associated with the claimed nucleic acid fragment. Therefore the scope can encompass any particular reasonable length that can fit into a nucleic acid vector. Additionally, the claims do not require that the first nucleic acid fragment be identical to the first cold shock inducible gene, the fragment can be identical to any sequence within the bacterial nucleic acid molecule which comprises the first cold shock inducible gene.

As stated previously, the genus of nucleic acids encompassed by the instant claims is very broad, since the claims encompass "a fragment" of unknown length, structure and source, and there is no clear correlation between the claimed structures and the recited function. Apart from further experimentation, the skilled artisan would not be able to predict the structures of the full scope of nucleic acid molecules encompassed by the instant claims.

Conclusion

6. Claims 1, 5-6,10, and 14-15 are free of the prior art searched.
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 9:30 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave T. Nguyen can be reached on 517-272-0731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Janet L. Epps-Ford
Primary Examiner
Art Unit 1633

JLE